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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,036	12/07/2001	Matthew S. Grob	PA661C1	6964
23696	7590	08/24/2005	EXAMINER	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			BHATTACHARYA, SAM	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/020,036	GROB ET AL.	
	Examiner Sam Bhattacharya	Art Unit 2687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 May 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,6-8,12,13,15-21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,6-8,12,13,15,17-21,23 and 25-31 is/are rejected.
- 7) Claim(s) 16 and 24 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/31/05 has been entered.

### ***Claim Objections***

2. Claims 30 and 31 are objected to because of the following informalities: in line 1 of each claim, "wires" should be changed to --"wireless"--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6, 7, 12, 13, 15, 17-21, 23 and 25-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Padovani et al. (US 6,151,502).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1, 3, 10-12, 17, 18, 20, 25, 26, 30 and 31, Padovani et al. discloses an apparatus and method for soft handoff, including a mobile station 2 with at least one processor 62, configured to measure the power of the pilot channels received from a plurality of base station transceivers at the mobile station, identifying the first channels whose measured signal powers are greater than a threshold at the mobile station, placing indicators of the identified first channels to a first set at the mobile station, searching for a direction message using the indicators contained in the first set, transmitting the indicators from the first set, and establishing a traffic channel to at least one of the identified base stations not in communication with the mobile station via a traffic channel. See FIGS. 1-3, col. 5, lines 63-66, col. 6, lines 11-65 and col. 8, lines 5-51.

Regarding claims 2, 4, 13, 19, 21, 27, 30 and 31, Padovani et al. discloses determining indicators of the identified base station and pilot channel not included in the first set, placing the determined indicators in the first set as the revised active set and transmitting the determined indicators. See col. 8, lines 43-47.

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Regarding claims 5, 6, 15 and 23, Padovani et al. discloses receiving transmission of indicators by the base station and sending a direction message to the mobile station if the base station is identified by the indicators. See col. 8, lines 10-22.

Regarding claim 7, Padovani et al. discloses that the direction message is a handoff direction message that inherently identifies a neighboring base station.

Regarding claims 28 and 29, Padovani et al. discloses a memory 56 embodying instructions executable by the at least one processor.

*Allowable Subject Matter*

5. Claims 16 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: claims 16 and 24 are objected to for the reasons stated a previous Office Action.

*Response to Arguments*

7. Applicant's arguments filed 11/22/04 have been fully considered but they are not persuasive.

Examiner previously indicated allowable the limitation of using the indicators in the first set to search for a direction message. Accordingly, Applicant incorporated this limitation into the independent claims. However, upon further consideration, Examiner now asserts that

Padovani teaches this limitation because the handover direction message must first be searched based on the indicators in the first set before the message is generated. See col. 8, lines 10-22.

*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Averbuch (US 5,268,933) discloses a method soft handoff based on determining signal strength.

Illidge (US 6,101,394) discloses a method of directing a handoff message.

Onada et al. (US 5,117,502) discloses a system for performing handoff based on a signal with the greatest field intensity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (571) 272-7917. The examiner can normally be reached on Weekdays, 9-6, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sb

*Lester G. Kincaid*  
8/18/05  
LESTER G. KINCAID  
SUPERVISORY PRIMARY EXAMINER